

REMARKS

Claims 1-62, and 64-78 are pending, claims 1-40, 66-74 and 78 being withdrawn from consideration. Applicant respectfully requests reconsideration by the Examiner in light of the following remarks.

In the present Office Action the Examiner has rejected claims 41-62, 64, 65, and 75-77 under 35 U.S.C. § 112, first paragraph, for lack of enablement. Specifically, the Examiner has stated that while the specification is “enabling for an addition polymer comprising a poly(ethylene glycol (meth) acrylate, and alkenoic acid, an ethylenic photoderivatized monomer and alkenyl substituted amides, [it] does not reasonably provide enablement for a polymer comprising any polyester, any photoderivatized monomer and any hydrophobic monomer made by any process.” The Examiner suggested that Applicants disclosed only the above-cited polymer in Examples 4-6, and that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate with the scope of the claims.

As is well known, to make a proper lack of enablement rejection under 35 U.S.C. § 112, first paragraph, the Examiner has the initial burden to show that the specification does not teach those skilled in the art how to make and use the full scope of the claimed invention without “undue experimentation.” See In re Wright, 999 F.2d 1557, 1562 (Fed. Cir. 1993); MPEP § 2164.04. If a prima facie case of lack of enablement is properly made by the Examiner, all that Applicants must show is that one skilled in the art to which the invention pertains would be able to practice the claimed invention in light of the specification given the level of knowledge and skill in the art, and the scope of enablement must only bear a “reasonable correlation” to the

scope of the claims.. In re Fisher, 427 F.2d 833, 839 (CCPA 1970); MPEP §§ 2164.05(a) & 2164.08.

How a teaching is set forth, such as by specific example or broad terminology, is not important to the question of enablement. MPEP § 2164.08. Accordingly, working examples of each embodiment encompassed by the claims are not required to enable. MPEP § 2164.02. In fact, an application may be fully enabling without any working examples. Id. Further, for a claimed genus, representative examples together with a statement applicable to the genus as a whole will ordinarily be sufficient if one skilled in the art would expect the claimed genus could be used in that manner without undue experimentation. Id.

Independent claim 41, and the claims depending therefrom, includes the step of providing a polymeric reagent formed by the polymerization of about 1 to about 20 mole % of a polyether monomer; about 5 to about 75 mole % of a carboxylic acid-containing monomer, such that the effective ratio of ether groups to carboxylic acid groups in the resultant copolymer is between about 1 to 1 and about 10 to 1; optionally, about 0.1 to about 10 mole % of a photoderivatized monomer; and an amount of a hydrophilic monomer suitable to bring the composition to 100%.

The pending claims are enabled by the application as filed. Each of the elements in independent claim 41 are disclosed in the detailed description. For example, polyether monomers are disclosed from page 9, line 19 to page 10, line 5, carboxylic acid-containing monomers are disclosed at page 10, lines 6-17, photoderivatized monomers are disclosed from page 10, line 18 to page 14, line 3, and hydrophilic monomers are disclosed at page 14, lines 4-16.

In addition, working examples are provided to illustrate certain embodiments of the invention. Moreover, the working examples provide examples of polyether monomers, carboxylic acid-containing monomers, photoderivatized monomers, and hydrophilic monomers. Specifically, Example 4 details the preparation of polyacrylamide(36%)co-Methacrylic acid(MA)-(10%)co-Methoxy PEG1000MA-(4%)co-BBA-APMA, which includes a polyether monomer (e.g., methoxy PEGMA), a carboxylic acid-containing monomer (e.g., methacrylic acid), a hydrophilic monomer (e.g., acrylamide) and a photoderivatized monomer (e.g., BBA-APMA). In addition, Example 5 provides at least twelve various analogs of this compound.

The discussion of each constituent of the polymeric reagent as cited above, particularly in view of the working examples given, fully enables a person reasonably skilled in this art to make and use the claimed invention without undue experimentation. As stated above, a representative example together with a statement applicable to the genus as a whole will ordinarily be sufficient to enable. In this case, not only is each constituent of the claimed reagent disclosed in the detailed description, but detailed examples are also given to enable the claims. Therefore, the discussion and the examples adequately enable the claims under 35 U.S.C. § 112, first paragraph.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



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